

Application No.: 10/717,887

Applicants respectfully note that the Office Action Summary incorrectly indicated that the present action (August 24, 2005) was a non-final rejection of the claims. Nonetheless, Applicants understand the Detailed Action to set forth a final rejection to which Applicants are responding accordingly. However, Applicants also understand the §102(e) rejection to be limited to claims 8 – 13 as no discussion of independent claim 14 is found therein. This response is also accompanied by a Notice of Appeal and Request for a Pre-Appeal Brief Conference.

Turning to the office action, claims 8 – 14 were again rejected under 35 USC §102(e) as being anticipated by Wong et al. (6,775,164). Claims 1 – 7 and 14 – 21 were rejected under 35 USC §103(a) as being unpatentable over Squibb (5,499,184) in combination with Keith (5,395,264).

I. Rejection of claims 8 – 13 respectfully traversed

With regard to the rejection based upon Wong, Applicants respectfully traverse the rejection as failing to teach all of the limitations recited in claim 8, as well as the limitations of dependent claims 9 – 13 (claim 14 believed included in error). Wong discloses a pulse width modulation (PWM) controller integrated circuit suitable for use in a switching power supply among other devices. Although Wong does teach several similar components, the specific limitations and relationships of the components as set forth in claim 8 is not disclosed by Wong. In particular, Applicants contend that there is no teaching in Wong of the encapsulation of the switching power supply as is now expressly recited in claim 8. Nor is there a disclosure that the MOSFET is connected to the DC return path of the bridge rectifier. Wong also fails to teach or suggest a voltage level detection circuit to maintain the MOSFET switch in an off state until a line voltage reaches a near zero threshold. Applicants note that the Examiner bases the rejection on a recited photodetector (64) – which appears to be erroneously cited in the rejection as both a photodetector and a detection circuit.

The resistive charging path, specifically recited as turning the MOSFET switch to an on state once the line voltage reaches the near zero threshold, has been alleged to be taught by a "bias pin 47" that enables bias power to be applied to the Wong integrated circuit (col. 4, lines 1 – 5). Applicants respectfully contend that such a teaching does not give rise to the claimed limitation. Lastly, claim 8 further recites "a resistive connection to a housekeeping supply of the power converter which

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maintains the MOSFET switch in the on state." The rejection alleges that such a limitation is taught by the AC connections of Wong. However, a careful review of the instant application reveals the recited housekeeping supply (depicted in FIGS. 4A and 4B) is in addition to the AC inputs. Thus, the recited housekeeping supply of the power converter cannot be taught by the Examiner's incorrect reference to AC connections. In view of the various limitations not taught by Wong, Applicants again urge that claim 8, and all claims dependent therefrom, are not anticipated under 35 USC §102(e) by Wong et al., and claims 8 - 13 are therefore in condition for allowance.

In the Examiner's remarks set forth at p. 2 of the Office Action, the Examiner alleges "also encapsulated circuit which known in the art" in response to Applicant's arguments, presumably relative to independent claim 8. However, the Examiner's response fails to address or even acknowledge the various other distinctions noted above between rejected independent claim 8 and the Wong teachings (e.g., the MOSFET connection, voltage level detection circuit, resistive charging path, and housekeeping supply). Moreover, the Examiner appears to rely upon Squibb (5,499,1984) as teaching the recited encapsulation as no such teaching is found in Wong. Applicants believe that such a position is wholly unsupported by the cited patent (notwithstanding the fact that Squibb is not even cited in the rejection of claim 8 under 35 USC §102). The Examiner has not indicated where, in Squibb, there is a teaching of encapsulation. Moreover, Applicants are unable to find the word encapsulate within the Squibb patent.

Applicants note, for the Examiner's careful consideration, that the term "encapsulate" has a meaning commonly used in the electrical engineering arts and that the term is used consistently in the instant application (e.g., lines 19-22 of the Specification state "the components are covered with the encapsulating material and the assembly is placed under a vacuum in order to draw air out of any pockets or voids within the assembled components. The encapsulating material is then allowed to cure before the converter is tested.") Absent a teaching of encapsulation or an encapsulating material as described in the present application, the rejection is unsupported and claim 8, and all claims dependent therefrom, are urged to be in condition for allowance.

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In view of the failure of the Office Action to set forth a teaching of each limitation of rejected independent claim 8, let alone its dependent claims, Applicants respectfully maintain that the finality of the present Office Action is also premature.

II. Rejection of claims under §102(a) is urged to be in error, is unsupported, and the finality thereof is premature.

Claim 14: Applicants further note that claim 14 has been indicated as being anticipated and as being obvious. However, in view of the fact that claim 14 is not addressed at all in the anticipation rejection under 35 USC §102, Applicants assume that the claim was erroneously included in the rejection under 35 USC §102 in the Office Action. Applicants seek acknowledgement of this error, or in the event the rejection is maintained for claim 14, Applicants respectfully request that the teachings relied upon relative to the limitations of claim 14 be set forth in the rejection. Absent such information, the rejection is incomplete and the finality thereof premature.

III. Rejection of claims 1 – 7 and 14 – 21 under 35 USC §103(a) is respectfully traversed

Considering now the rejection under 35 USC §103(a), the disclosures of the cited art and the distinctions between claims 1 – 7 and 14 - 21 may be briefly summarized as follows:

Squibb is directed to a power switching circuit for remotely activating a power supply, where the power switch is electrically isolated from the primary of the power supply, and teaches how to use an auxiliary oscillator to provide a low voltage isolated remote on/off control. To the best of Applicants knowledge, in addition to failing to teach a detachable line cord (not being a power converter, but a remotely controllable aspect of a power supply), Squibb also fails to teach the use of an encapsulant for high-voltage electronic circuitry in a power converter (as recited in claim 1), as noted above.

The rejection also fails to set forth where the various elements of claim 14 are found in Squibb or Keith , for example, a circuit board located within an electronic device, a cover enclosing the electronic device, an electronic power converter including fully encapsulated electronic circuitry; and an integrated connector, accessed through an aperture in the cover, for receiving a detachable line cord having at least two wires

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therein, wherein the power converter is mounted on said circuit board. Absent teaching of the recited elements, no *prima facie* obviousness has been established, and the rejection is traversed.

With respect to the various limitations of the rejected dependent claims, Applicants once again urge that resistor 58 of Squibb, cited in the rejection, cannot give rise to the recited inrush current limiting circuit. Applicants refer the Examiner to the function of the inrush circuit embodiments depicted in FIGS. 4A and 4B, and the general description where "the inrush current controller 112, holds back on the input voltage from line 102 until such a time when the incoming AC voltage is near zero. At that time, circuit 112, connects capacitor(s) 130 to the bridge rectifier, allowing capacitor(s) 130 to charge with the rising sinusoidal voltage waveform." (p. 6, line 28 – p. 7, line 4 – 8). In view of Applicant's disclosure of the inrush current limiting circuit, no such teaching is believed to be found in Squibb.

Similarly, relative to the various dependent claims, while certain electrical components are taught, Squibb fails to teach or suggest the specific limitations set forth in the dependent claims. For example, although an opto-coupler is disclosed, there does not appear to be any characterization of its use to "to disable the power supply output in response to the signal received by the photo-detector," as recited in claims 3 or 18. With reference to claims 6 and 21, these claims recite a "secondary side, isolated low voltage ON/OFF function" implemented by circuitry including a peak detector for sensing the instantaneous primary rectified voltage connected to a linear regulator / voltage limiting circuit, connected to a light emitter of an opto-coupler, said opto-coupler being further connected to an error amplifier and an ON/OFF pin in such a manner as to provide a isolated secondary low voltage indication of the primary line voltage and to allow the user to turn the device off." Here again, no such teaching of the interrelationship between components is believed to be taught or suggested in Squibb.

Moreover, the rejection fails to set forth specific reference to other aspects of Squibb that are allegedly relied upon to disclose or suggest limitations found in the present claims. In the event the rejection is maintained, Applicants respectfully request that particular teachings be set forth for each claim limitation and not just for general components found in circuits. For example, claims 2 and 17 recite a "MOSFET switch connected to the DC return path of the bridge rectifier" (emphasis added).

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Although a MOSFET may be taught, the recited configuration and use of claims 2 and 17 have not been disclosed in Squibb. Applicant's further note that in response to arguments similar to those presented above, the Examiner's Response to Arguments found in the present Office Action, once again fails to indicate the basis for the rejection. Hence, Applicants again urge that the limitations recited are not taught by merely picking from a figure an electrical component similar to that recited in the claim limitation – to do so improperly ignores the structural and functional limitations of the rejected claims.

In view of the above-noted claim limitations (independent and dependent), Applicants respectfully submit that the teachings of Squibb fall far short of actually disclosing the claim elements alleged to be taught therein, and that *prima facie* obviousness cannot be established to which Applicants can or should further respond based upon Squibb.

Keith, cited for teaching an integrated connector in a power controller, actually teaches the use of a standard AC extension cord to pass audio signals. Not only does Keith fail to teach or suggest a power controller having an integrated connector (claims 1 and 14), the patent also fails to suggest "connection to an AC utility line source that is independent of the circuit board to which the power converter is attached" (claim 15). Accordingly, the recited "teachings" relative to an integrated connector do not appear in any way to suggest the limitations set forth in the rejected claims. In fact, the teachings of Keith relate to use of AC extension cords as audio cables, is entirely contrary to the present invention (and to Squibb) – as a source of power for a power converter. Thus, Keith also clearly teaches away from the proposed use or modification. Again Applicants note with concern that the present Office Action does not address this clear error in the rejection.

With respect to the proposed combination of Squibb and Keith, there is simply no basis identified in the rejection for urging that one of ordinary skill in the art would have been motivated to make such a combination or modification. The only commonality between Squibb and Keith is that the term AC is used by Keith - Keith clearly teaches an alternative, and incompatible, use of AC cords for audio signal transmission. The Examiner's basis for the combination is "for the purpose of providing power supply that can be used with standard power supply." Applicants respectfully question what such a statement is intended to convey as a suggestion to

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combine or modify the references relied upon, let alone where that basis is taught or suggested by Squibb, Keith or was otherwise known in the art. Given that the combination of Squibb and Keith would render either invention wholly inoperable, there cannot be any basis for the proposed combination – other than Applicants' claims, which appear to have been employed as a "recipe" for hindsight reconstruction of the invention.

In view of the above-noted distinctions, as well as the lack of any teaching or suggestion by which one of skill in the art would be motivated to combine or modify Squibb and Keith, Applicants respectfully contend that claims 1 and 14 are presently in condition for allowance, the rejection having been traversed. Insofar as claims 2 – 6 and 15 – 21 are concerned, these claims all depend from now presumably allowable amended claims 1 or 14 and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to such claims.

This response submits no new amendments to the claims. Rather, the response sets forth, in particularity, various arguments in traversal of the continued rejections. Applicants note that similar arguments were provided in response to the first Office Action, at considerable time and expense to Applicants, and that the Examiner's failure to address all arguments submitted in traversal of the rejection, or to provide adequate evidence of the teachings and bases relied upon for the rejection, suggests that a complete examination and review of Applicant's response has not been conducted.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

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In the event the Examiner considers personal contact advantageous to the timely disposition of this case, he is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



Duane C. Basch
Attorney for Applicant
Registration No. 34,545

Basch & Nickerson LLP
1777 Penfield Road
Penfield, New York 14526
(585) 899-3970

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